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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,762	11/09/2001	Petter Ericson	3782-0196P	5644

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EXAMINER

TRAN, HENRY N

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 01/07/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/986,762

Applicant(s)

ERICSON ET AL.

Examiner

HENRY N TRAN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7,8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Office action is in response to the applicant's amendment received 3/18/02 (Paper No. 5). The amendments to the claims have been entered. Claims 1-30 are pending in this application. Applicant's remarks were considered, with the results set forth as following.

#### ***Information Disclosure Statement***

1. The examiner has considered the information disclosure statements (IDSs) received 4/1/02 and 6/12/02 (Paper Nos. 7 and 8) (see the attached forms PTO-1449).

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzouni et al (U.S. Patent No. 5,661,506) in view of O'Connor et al (U.S. Patent No. 6,188,392).
4. Regarding claims 1, 15, 18, 26 and 30, over Lazzouni et al teach a system for information management, comprising a hand-held pen 10 having a writing tip 18 and an imaging system 24 as means for writing and recording handwritten information; a communication interface 154 as means for transferring information from a first memory unit 146 to a second memory unit, which is an external memory, arranged in the host computer 152, wherein, in the first memory

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management mode, information is firstly stored in the first memory 146, and then in the second memory management mode, information stored in the memory is transferred to the host computer memory using the communication link 154 (see figures 1 and 10; col. 4, lines 37-50; col. 8, line 59 to col. 9, line 29). However, Lazzouni et al do not teach expressly that the first memory unit is an internal memory unit located in the hand-held pen 10 and the memory capacity is reserved in an external memory for receiving and storing the recorded information provided by the pen 10. O'Connor et al teach a system for writing and recording handwritten information comprising a pen 100 having an internal memory unit 120 for storing recorded information for transmitting to a host computer 130; and memory capacity is reserved to stored accumulated information (see figures 1 and 2; col. 1, lines 52-53. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of O'Connor et al discussed above in the Lazzouni et al device because this would provide an improved compact pen-computer interface which is enable a user to conveniently and effectively utilize the pen for entering data to a computer. By this rationale, claims 1, 15, 18, 26 and 30 are rejected.

5. Regarding claims 2-14, 16, 17, 19-25 and 27-29, Lazzouni et al further teach: information includes absolute position information, which is transferred using a predetermined rules provided by a frame processing system 142 (see col. 4, line 19); the imaging system 24 is an imaging sensor for optical recording a position on encoded paper base 14 (see col. 6, line 5). O'Connor et al further teach the memory capacity is reserved for to stored accumulating input data which is transferred to the computer in a certain period of time using a wireless interface 119 (see references recited above). Official notice is taken for the claim term "an address for the

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information” because memory utilizes addresses for defining memory locations for storing data is old and well-know in the art of memory addressing. Claims 2-14, 16, 17, 19-25 and 27-29 are dependent upon base claims 1, 15, 18 and 26, and are therefore rejected on the same reasons set forth in claims 1, 15, 18 and 26, and by the reasons discussed above.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They are U.S. Patent Nos.: 6592039, 6002387, 6563494, and 6486875, which teaches pen input systems which have an internal memory for storing input data for transferring to host computers.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HENRY N. TRAN whose telephone number is 703-308-8410.

The examiner can normally be reached on Mon – Fri from 8:00AM – 4:30PM.

If attempts to read the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD A. HJERPE, can be reached at 703-305-4709.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or fax to:**

703-872-9306

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is 703-306-0377.

*Henry N. Tran*

HENRY N. TRAN  
Examiner  
Art Unit 2674

Hnt  
January 2, 2004